

S/N 09/921,457
Art Unit 1746
Atty Dkt CBC 2001-10

I. Objection to Claims 7, 10 and 24

Dependent claims 7, 10 and 24 are objected to under 37 CFR §1.75(c) as being of improper dependent form. The Examiner asserts that claims 7 and 24 are directed to the article to be cleaned and, as such, do not provide any further structural limitation to the claimed apparatus. The Examiner also asserts that claim 10 is directed to the location of the object to be washed and, thus, also fails to provide further structural limitation. See, the Office action mailed August 5, 2003, page 4, paragraph 10.

In a response filed November 4, 2003, applicants amended the claims, for example, to recite a "system" rather than a "washer". See, applicants' response filed November 4, 2003.

In the final Office action (page 4, paragraph 2), the Examiner states the following:

The objection to claims 7, 10 and 24 has been maintained for reasons of record. In response to Applicant's amendment of the preamble from an "apparatus" to a "system", this language does not provide any further structural limitation to the claimed apparatus.

Applicants respectfully point out that, contrary to the Examiner's assertion, it was not *just* the preamble that was amended. The *body* of claim 1 (from which claims 7 and 10 ultimately depend) was also amended to positively recite at least one object as being part of the system. Applicants' previously presented amendment to Claim 1 reads as follows:

1. A washer for washing objects, said washer system comprising:

at least one object to be washed; and

a washer comprising:

a housing;

a rotatable member rotatably mounted to said housing at

S/N 09/921,457
Art Unit 1746
Atty Dkt CBC 2001-10

a rotation axis;

wherein, said rotatable member has an outer peripheral surface extending in a direction parallel to said rotation axis;

~~at least one stationary member~~ a rail stationarily mounted to said housing; and

wherein, ~~at least one~~ of said objects is in contact with both said rotatable member outer peripheral surface and said ~~stationary member~~ rail.

(emphasis added)

Accordingly, claim 1 now positively recites, as structure, the object to be washed in the *body of the claim*. Dependent claims 7 and 10, thus, recite further limitations directed to a positively-recited structural feature of the claim.

The *body* of claim 19 (from which claim 24 ultimately depend) was also amended to positively recite at least one object as being part of the system. Applicants' previously presented amendment to Claim 1 reads as follows:

19. A washer for washing objects, ~~said washer system~~ comprising:

at least one object to be washed; and

a washer comprising:

a housing;

a rotatable member rotatably mounted to said housing at a rotation axis;

~~at least one stationary member~~ a rail stationarily mounted to said housing;

wherein, ~~at least one~~ of said objects is located between said

S/N 09/921,457
Art Unit 1746
Atty Dkt CBC 2001-10

rotatable member and said at least one stationary member rail; and
wherein, said at least one of said objects is in contact with both
said rotatable member and said stationary member rail.

(emphasis added)

Accordingly, claim 19 now positively recites, as structure, the object to be washed in the *body of the claim*. Dependent claim 24, thus, recites a further limitation directed to a positively-recited structural feature of the claim.

For the reasons set forth above, reconsideration of the objection to claims 7, 10 and 24 is respectfully requested.

S/N 09/921,457
Art Unit 1746
Atty Dkt CBC 2001-10

II. Legal Basis for Prior Art Rejections Applied in the Office Action

Legal Basis for Anticipation under 35 U.S.C. §102

The standard for lack of novelty, that is, for "anticipation," under 35 U.S.C. 102 is one of strict identity. To anticipate a claim for a patent, a single prior source must contain all its essential elements. *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 231 USPQ 81, 90 (Fed. Cir. 1986).

Legal Basis for Obviousness under 35 U.S.C. §103

The test for obviousness under 35 U.S.C. 103 is whether the claimed invention would have been obvious to those skilled in the art in light of the knowledge made available by the reference or references. *In re Donovan*, 184 USPQ 414, 420, n. 3 (CCPA 1975). It requires consideration of the entirety of the disclosures of the references. *In re Rinehart*, 189 USPQ 143, 146 (CCPA 1976). All limitations of the Claims must be considered. *In re Boe*, 184 USPQ 38, 40 (CCPA 1974). In making a determination as to obviousness, the references must be read without benefit of applicants' teachings. *In re Meng*, 181 USPQ 94, 97 (CCPA 1974). In addition, the propriety of a Section 103 rejection is to be determined by whether the reference teachings appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed substitution, combination, or other modifications. *In re Lintner*, 173 USPQ 560, 562 (CCPA 1972).

A basic mandate inherent in Section 103 is that a piecemeal reconstruction of prior art patents shall not be the basis for a holding of obviousness. It is impermissible within the framework of Section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. *In re Kamm*, 172 USPQ 298, 301-302 (CCPA 1972). Phrased somewhat

S/N 09/921,457
Art Unit 1746
Atty Dkt CBC 2001-10

differently, the fact that inventions of the references and of applicants may be directed to concepts for solving the same problem does not serve as a basis for arbitrarily choosing elements from references to attempt to fashion applicants' claimed invention. In re Donovan, 184 USPQ 414, 420 (CCPA 1975). It is also clearly established in the case law that a change in the mode of operation of a device which renders that device inoperative for its stated utility as set forth in the cited reference renders the reference improper for use to support an obviousness-type rejection predicated on such a change. See, e.g. Diamond International Corp. v. Walterhoefer, 289 F.Supp. 550, 159 USPQ 452, 460-61 (D.Md. 1968); Ex parte Weber, 154 USPQ 491, 492 (Bd.App. 1967). In addition, any attempt to combine the teaching of one reference with that of another in such a manner as to render the invention of the first reference inoperative is not permissible. See, e.g., Ex parte Hartmann, 186 USPQ 366 (Bd.App. 1974); and Ex parte Sternau, 155 USPQ 733

In the case of In re Wright, 6 USPQ 2d 1959 (CAFC 1988), the CAFC decided that the Patent Office had improperly combined references which did not suggest the properties and results of the applicants' invention nor suggest the claimed combination as a solution to the problem which applicants' invention solved.

The CCPA reached this conclusion after an analysis of the prior case law, at p. 1961:

We repeat the mandate of 35 U.S.C. 103: it is the invention as a whole that must be considered in obviousness determinations. The invention as a whole embraces the structure, its properties, and the problem it solves. See, e.g., Cable Electric Products, Inc. v. Genmark Inc., 770 F.2d 1015, 1025, 226 USPQ 881, 886 (Fed. Cir. 1985) ("In evaluating obviousness, the hypothetical person of ordinary skill in the pertinent art is presumed to have the 'ability to select and utilize knowledge from other arts reasonably pertinent to [the] particular problem' to which the invention is directed"), quoting In re Antle, 444 F.2d 1168, 1171-72, 170 USPQ 285, 287-88 (CCPA 1971); In re Antonie, 559 F.2d 618, 619, 195 USPQ 6, 8 (CCPA 1977) ("In

S/N 09/921,457
Art Unit 1746
Atty Dkt CBC 2001-10

delineating the invention as a whole, we look not only in the claim in question... but also to those properties of the subject matter which are inherent in the subject matter and are disclosed in the Specification") (emphasis in original).

The determination of whether a novel structure is or is not "obvious" requires cognizance of the properties of that structure and the problem which it solves, viewed in light of the teachings of the prior art. See, e.g., In re Rinehart, 531 F.2d 1048, 1054, 189 USPQ 143, 149 (CCPA 1976) (the particular problem facing the inventor must be considered in determining obviousness); see also Lindemann Maschinenfabrik GmbH v. American Hoist and Derrick Co., 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984) (it is error to focus "solely on the product created, rather than on the obviousness or notoriety of its creation") (quoting General Motors Corp. v. U.S. Int'l Trade Comm'n, 687 F.2d 476, 483, 215 USPQ 484, 489 (CCPA 1982), cert. denied, 459 U.S. 1105 (1983)).

Thus the question is whether what the inventor did would have been obvious to one of ordinary skill in the art attempting to solve the problem upon which the inventor was working. Rinehart, 531 F.2d at 1054, 189 USPQ at 149; see also In re Benno, 768 F.2d 1340, 1345, 226 USPQ 683, 687 (Fed. Cir. 1985) ("appellant's problem" and the prior art present different problems requiring different solutions").

A reference which teaches away from the applicants' invention may not properly be used in framing a 35 U.S.C. 103 rejection of applicants' claims. See United States v. Adams, 148 USPQ 429 (Sup. Ct. 1966).

S/N 09/921,457
Art Unit 1746
Atty Dkt CBC 2001-10

III. Rejection of Claims 1-6, 9 and 19-23 under 35 U.S.C. §102(b)

Claims 1-6, 9 and 19-23 stand rejected under 35 U.S.C. §102(b) as being anticipated by Hulskotte (U.S. 5,875,800). Reexamination and reconsideration are requested.

Claims 1-6 and 9

Claim 1 recites the following:

1. A system comprising:

at least one object to be washed; and
a washer comprising:

a housing;

a rotatable member rotatably mounted to said housing at a rotation axis;

wherein, said rotatable member has an outer peripheral surface extending in a direction parallel to said rotation axis;

a rail stationarily mounted to said housing; and

wherein, said object is in contact with both said rotatable member outer peripheral surface and said rail.

(emphasis added)

Claim 1 recites, for example, "**at least one object to be washed**" and:

wherein, said object is in contact with both said rotatable member outer peripheral surface and said rail.

S/N 09/921,457
Art Unit 1746
Atty Dkt CBC 2001-10

In the Hulskotte reference, the articles being washed (e.g., the knives 10 in Fig. 1) are contained within a number of cylindrical cleaning chambers 4. Therefore, the articles being washed in Hulskotte only contact the cleaning chambers 4 and not an "outer peripheral surface" or a "rail" as recited in applicants' claim 1.

The Examiner apparently does not disagree with the above-stated analysis of Hulskotte, but instead takes the position that applicants' recitations regarding the object to be washed are not limiting. Specifically, the Examiner states the following on page 5 of the final Office action:

It is noted that Applicant's limitations in claims 1 & 19 directed to the object to be washed (and the "wherein ..." limitations associated therewith) are given little patentable weight and are considered intended use of the apparatus. MPEP 2115 and caselaw is replete with teachings disclosing that expressions relating an apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim. *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969). Furthermore, "[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims." *In re Young*, 75 F.2d 966, 25 USPQ 69 (CCPA 1935) (as restated in *In re Otto*, 312 F.2d 937, 136 USPQ 458, 459 (CCPA 1963)).

In response to the Examiner's assertion, applicants note that MPEP 2115, as well as the cases cited above by the Examiner, appear to apply to situations in which the *only* difference between an apparatus claim and the prior art is a recitation relating to the intended use of the apparatus - in other words, situations in which *all* of the *structural* limitations of the claim are met by the prior art.

A somewhat more recent Board of Appeals decision discusses, in a relevant context, several of the cases cited above by the Examiner:

At any rate, a recitation with respect to the material intended to be worked upon by a claimed apparatus does not impose any structural

S/N 09/921,457
Art Unit 1746
Atty Dkt CBC 2001-10

limitations upon the claimed apparatus which differentiates it from a prior art apparatus satisfying the *structural* limitations of that claimed. See *In re Rishol*, 197 F.2d 342, 94 USPQ 71 (CCPA 1952) and *In re Young*, 75 F.2d 996, 25 USPQ 69 (CCPA 1935). Similarly, a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the *structural* limitations of that claimed. See *In re Yanush*, 477 F.2d 958, 177 USPQ 705 (CCPA 1973), *In re Finsterwalder*, 436 F.2d 1028, 168 USPQ 530 (CCPA 1971), *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 136 USPQ 458 (CCPA 1963).

Ex parte Masham, 2 USPQ2d 1647 at 1648 (Bd. App. 1987) (italics in original, bold emphasis added)

In emphasizing above the term "structural", the Board of Appeals stresses that the cases in question only apply when the structural limitations of the claim in question are met by the prior art. In other words, applicability of these cases is limited to situations in which the only difference between a claim and the prior art is the recitation in the claim of an item *intended* to be worked on or the manner in which the claimed apparatus is *intended* to operate.

Contrary to the Examiner's assertion, applicants' claim 1 does not merely recite an "intended use" of an apparatus. Rather, claim 1 recites a *system* comprising both at least one object to be washed and a washer. Claim 1, thus, *positively recites the object to be washed as structure* and not as an intended use.

For the reasons set forth above, applicants respectfully assert that it is improper for the Examiner to refuse to afford patentable weight to the claim 1 limitations in question. Further, since, as discussed above, these limitations are not met by Hulskotte, claim 1 is not anticipated by Hulskotte. As pointed out previously, to anticipate a claim for a patent, a single prior source must contain all its essential elements. *Hybritech, Inc. v. Monoclonal Antibodies*,

S/N 09/921,457
Art Unit 1746
Atty Dkt CBC 2001-10

Claims 2-6 and 9 are allowable at least as depending from allowable base claim 1.

Claims 19-23

Claim 19 recites the following:

19. A system comprising:
at least one object to be washed; and
a washer comprising:
 a housing;
 a rotatable member rotatably mounted to said housing at a rotation axis;
 a rail stationarily mounted to said housing;
 wherein, said object is located between said rotatable member and said rail; and
 wherein, said object is in contact with both said rotatable member and said rail.

(emphasis added)

Claim 19 recites, for example, "**at least one object to be washed**" and:

wherein, said object is in contact with both said rotatable member and said rail.

Accordingly, claim 19 is allowable for at least the reasons advanced

S/N 09/921,457
Art Unit 1746
Atty Dkt CBC 2001-10

above with respect to claim 1.

Claims 20-23 are allowable at least as depending from allowable base
claim 19.

S/N 09/921,457
Art Unit 1746
Atty Dkt CBC 2001-10

IV. Rejection of Claims 8 and 25 under 35 U.S.C. §103(a)

Claims 8 and 25 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Hulskotte (U.S. 5,875,800) in view of Flynn (U.S. 3,942,545). Reexamination and reconsideration are requested.

Claims 8 and 25 are allowable at least as depending from allowable base claims 1 and 19, respectively.

For the reasons advanced above, applicant respectfully asserts that all of the claims are in condition for allowance.

Respectfully submitted,

KLAAS, LAW, O'MEARA & MALKIN, P.C.

By


Michael A. Goodwin, Reg. No. 32,697
KLAAS, LAW, O'MEARA & MALKIN, P.C.
1999 Broadway, Suite 2225
Denver, CO 80202
Telephone: (303) 298-9888
Fax: (303) 297-2266
Date: March 2, 2004

Page 14 of 14